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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,488	04/23/2001	Klaus-Juergen Pees	33350-03	5506

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NOVAK DRUCE DELUCA & QUIGG, LLP
1300 EYE STREET NW
SUITE 400 EAST
WASHINGTON, DC 20005

EXAMINER

BERCH, MARK L

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,488

Applicant(s)

PEES ET AL.

Examiner

Mark L. Berch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/21/2005 has been entered.

Claim Rejections - 35 USC § 112

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the other metals, does not reasonably provide enablement for Zinc. $M = \text{Zn}$ is impossible. Formula III, the reactant or starting material, is as follows:



Formula III calls for a metal in the valence state of +1, since the amino part of the molecule carries a charge of -1. The formula clearly shows one amine and one metal.

Unlike the other metals of claim 9, Zn does not have a valence state of +1. Zn cannot form a molecule of Formula III as a result.

It is a little difficult to tell exactly what appellants are arguing here in the Appeal Brief. On the one hand, appellants stated, "The preparation of a compound (III) wherein M represents Zn is well known." But on the other hand appellants state that a reasonable person "would not attempt to produce a compound (III) wherein M represents Zn in the valence state +1." It is not easy to reconcile these two statements, since compound (III) clearly depicts a metal in the valence state +1.

The only hint of how appellants reconcile such seeming contradictions is this (fifth from last line of page 5 of Appeal Brief): "The mere fact that formula (III) appears to call for a metal having a valence state of +1...." This is repeated on page 6, last paragraph before the conclusion, where "appears" is in italics. The use of "appears" in these two sentences seems to imply that appellants don't think that the formula does call for a valence state of +1, but only "appears" to. However, the Appeal Brief is somewhat coy on the subject, not coming right out and saying that it is not +1. The closest is this from page 6: "A reasonable person of ordinary skill in the art would, therefore, not interpret appellants' formula (III) as requiring the presence of Zn in a valence state of +1." This is unpersuasive for two reasons. First, Formula III does not require any interpretation at all. It is perfectly clear and unambiguous, and for the other metals, not problematic. It is simply impossible for Zn because unlike the other metals, Zn does not have a +1 state. And second, while appellants say this is the wrong way to "interpret" the claim, they do not state what is the right way to "interpret" the claim.

Instead, appellants argue that the valence state is somehow not "critical or even significant". But if the reagent is not possible to exist, that would certainly be significant.

There are basically five possibilities here for the Formula III.

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A. The formula is right, because that somehow a Zn(I) compound has uniquely been made here. The brief, however, seems to reject that approach, although not explicitly.

B. There may have been a typographical error; instead of Zn there was intended In.

Indium does form the valence state +1.

C. The wrong metal may have appeared. Since the metal after Zn is Cu, perhaps Ag was intended. Since the metal before Zn was K, perhaps Rb was intended.

D. The wrong stoichiometry may appear; the formula should have two amine anions for the Zn, not just one.

E. The Zn should have been coupled with e.g. a halide. Thus, if the claim had M as ZnCl rather than Zn, that would have a net charge of +1 and solve the problem.

Appellants should have figured out what the error was, if it is in error, and fixed it.

An error can be corrected provided that there is not "reasonable debate" as to what the correct text would be, *Novo Industries, L.P. vs. Micro Molds Corp.*, 350 F.3d 1348, 69 USPQ2d 1128 (2003). Here, clearly there is more than one possibility, as was the case in *Novo Industries* as well. In such a case, one must show that one of ordinary skill in the art would have been able to determine for sure what was intended, *Ex parte Brodbeck*, 199 USPQ 230. Failing that, Zn should have been removed.

As it stands, however, Formula III is not enabled because such a reagent cannot exist in the first place.

In the most recent submission applicants argue, "the mere fact that formula (III) appears not to call for a metal having a valence state of +1 will not cause...." This adds confusion to this case. First, this is the exact opposite of the argument presented in the Appeal Brief, viz., "formula (III) appears to call for a metal having a valence state of +1". As

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the Board Decision put the matter, “seemingly contradictory arguments do nothing to dispose of the issue.” The formula clearly does call for a valence state of +1. Applicants have presented no reasoning to explain why “formula (III) appears not to call for a metal having a valence state of +1”.

Applicants assert, without any evidence whatsoever, “valence state of a metal has no impact of the success of a transmetallation reaction.” This is a rebuttal of an assertion which the examiner has not made. The rejection has nothing whatsoever to do with whether the valence state affects the reaction. The rejection is based on the fact that the reagent does not exist for the M=Zn choice. If the reagent does not exist, then the claim is not enabled. MPEP 2164.08 states, “The Federal Circuit has repeatedly held that “the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation’.” In *re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).” The “full scope” means each member of a Markush group. When operativeness has been properly challenged, it is incumbent on applicant to limit the claims accordingly, cf. *In re Harwood*, 156 USPQ 673, *In re Cook*, 169 USPQ 298, *In re Langer*, 183 USPQ 288, *In re Corkill*, 226 USPQ 1005, 1009, and *In re Rainier*, 153 USPQ 802.

Applicants remarks further discuss whether undue experimentation is involved. The examiner has not made an argument concerning undue experimentation. Rather, the argument is that the reagent simply does not exist.

In order to advance the prosecution of this case, applicants are asked to specifically address these questions:

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I. Is the formula for the reagent correct? If it is not correct, then applicants should tender an amendment to correct the formula, being careful not to introduce new matter (see above discussion; if the correct choice is not one of B-E, applicants should indicate what it is).

II. If the Formula correct, does it depict Zn in an oxidation state of +1? In this regard, it will not be helpful if applicants continue to use equivocal language about either what the claim does have e.g. "formula (III) appears to call for a metal having a valence state of +1" or use equivocal language about what the claim does not have, e.g. "formula (III) appears not to call for a metal having a valence state of +1". Applicants need to make an affirmative statement about what the Formula (III) actually has, not what it "appears" to have or not have. If applicants are unable to state whether their own formula depicts Zn in an oxidation state of +1, they must explain why they cannot determine what their own claim says. If applicants believe that it does not depict Zn(I), applicants are asked to explain their reasoning, since the plain meaning clearly shows Zn(I).

III. If applicants believe that the reagent is Zn in the +1 oxidation state, they are asked to explain how such a reagent could possibly be made, since Zn does not have such a valence state. If applicants assert that the compound can be made, they must present evidence that this is so. If the compound cannot be made, that that will be definitive evidence that this choice in the Markush group is not enabled.

Please note that any argument that one of ordinary skill in the art would know how to make a Zn(I) compound, without any evidence to support such an assertion, will not be persuasive. This is because if applicants themselves cannot state specifically how to make such a reagent, then it is presumed that one of ordinary skill in the art cannot make it. Any argument that a claim is enabled even though the reagent does not exist will also be

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unpersuasive, unless applicants can show some legal basis for such an argument. It is well established that if a reagent or starting material is unavailable for a process, that process is not enabled, *Ex parte Moersch*, 104 USPQ 122. Note also *Ex parte Schwarze*, 151 USPQ 426.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Mark L. Berch
Primary Examiner
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10/14/05